

REMARKS

I. Status of the Claims

Claims 1-10, 12-18, 23, 24, 27-34 and 37-44 are pending and under consideration on the merits. As shown above, claims 1 and 30 have been amended to further define the claimed silicone. Claims 13, 15, 23, 24, 27-29, 37-44 have been withdrawn as directed to non-elected subject matter. Claims 11, 19-22, 25, 26, 35, 36 have been canceled.

Specifically, claim 1 has been amended to recite, *inter alia*, “[a] cosmetic composition comprising . . . at least one non-volatile polyorganosiloxane chosen from: polyalkylsiloxanes chosen from polydimethylsiloxanes comprising trimethylsilyl end groups” Claim 30 has been amended to recite similar claim elements, although in the form of a dependent claim.

Support for these amendments may be found in the as-filed specification and claims, for example, in original claims 20-22, and at page 32 of the as-filed specification. Applicants also note that it is well settled that Applicants need not claim all that they disclose. *See, e.g., In re Johnson*, 558 F.2d 1008 (C.C.P.A. 1977) (holding that a written description supporting a broader genus, and “having described the whole, necessarily described the part remaining”).

Like *Johnson*, the present claims merely excise a member (polydimethylsiloxanes comprising dimethylsilanol end groups) of an originally described genus. As established in *Johnson*, Applicants have the right to claim less than the full scope of their disclosure, and thus can exclude polydimethylsiloxanes comprising dimethylsilanol end groups without introducing any issue of new matter.

II. Summary of the Office Action

In the Office Action, the Office rejects claims 1-10, 12, 14, 16-18, and 30-34 under 35 U.S.C. § 112, second paragraph. See Office Action, page 2. In addition, the Office rejects claims 1-10, 12, 14, 16-18, and 30-34 under 35 U.S.C. § 103(a) as being unpatentable over Murray¹ in view of Sweger², Babenko³, and Saint-Leger⁴. See *id* at 3-7.

Applicants respectfully disagree with and traverse each of these rejections for at least the following reasons.

III. Response to Claim Rejections

A. 35 U.S.C. § 112, second paragraph rejection

The Office rejects 1-10, 12, 14, 16-18 and 30-34 under 35 U.S.C. § 112, second paragraph for the reasons set forth at pages 2 and 3 of the Office Action. In particular, the Office asserts that claim 1 recites both a broad range (i.e., poly(C₁-C₂₀) alkylsiloxanes) and “also recites polydimethylsiloxane comprising trimethylsilyl which is” a narrower range falling within the broad range. Office Action at 3.

Applicants respectfully disagree with the Office’s assertion that the language of claim 1 is unclear. Nonetheless, to address the Office’s position Applicants have amended claims 1 and 30 as shown above. In view of these amendments, Applicants

¹ Murray, U.S. Patent No. 5,720,964, issued February 24, 1998.

² Sweger et al., U.S. Patent No. 5,482,704, issued Jan. 9, 1996.

³ Babenko, U.S. Patent No. 6,277,893, issued Aug. 21, 2001.

⁴ Saint Leger, U.S. Patent No. 5,919,438, issued July 6, 1999.

respectfully submit that the 35 U.S.C. § 112, second paragraph rejection is moot, and should be withdrawn.

B. 35 U.S.C. § 103(a) rejection

The Office rejects claims 1-10, 12, 14, 16-18 and 30-34 under 35 U.S.C. § 103(a) as being allegedly unpatentable over Murray, Sweger et al, Babenko and Saint-Leger for the reasons set forth at pages 3-7 of the Office Action. In particular, the Office alleges that “a person of ordinary skill in the art would have considered it obvious to substitute the amphoteric starch disclosed by Sweger and Babenko for the Carbopol used in Murray’s composition, e.g., Example #2 composition, because of the superior performance taught by Sweger.” The Office Also asserts that the resulting composition “does not contain fatty acid soaps, and . . . [t]he employment of coconut isopropanolamide would have been obvious because . . . [it] is an ingredient particularly known to be useful in shampoo composition[s].” *Id.* at 6.

The Office further found the arguments submitted with the Amendment filed May 6, 2008, unpersuasive. In particular, the Office maintains that “[t]he amendments [filed May 6, 2008] do not exclude polydimethylsiloxane comprising dimethylsilanol end groups Furthermore, Murray teaches insoluble siloxane is generally known to be useful for shampoo[s].” *Id.* From this, the Office asserts that “substitution of dimethiconol with other siloxane known to be useful in shampoo composition[s] would have been obvious to one of ordinary skill in the art.”

Applicants respectfully disagree with and traverse this rejection for at least the reasons of record, which are incorporated herein by reference, as well as the following additional reasons.

In making a rejection under 35 U.S.C. § 103, the Office “bears the initial burden of factually supporting any *prima facie* conclusion of obviousness. See M.P.E.P. § 2142. In its decision in *KSR Int’l Co. v. Teleflex Inc.*, 127 S. Ct. 1727, 82 U.S.P.Q. 2d 1385 (2007), the Supreme Court confirmed that the “framework for applying the statutory language of §103” was still based on its landmark decision in *Graham v. John Deere Co. of Kansas City*, 383 U.S. 1, 148 U.S.P.Q. 459 (1966). Under *Graham*, there are four factors for consideration when determining whether an invention is obvious:

- (1) the scope and content of the prior art;
- (2) the differences between the prior art and the claims at issue;
- (3) the level of ordinary skill in the art; and
- (4) secondary considerations.

383 U.S. at 17, 148 U.S.P.Q. at 467. However, the Court indicated that there is no necessary inconsistency between the idea underlying the teaching, suggestion, or motivation (“TSM”) test and the *Graham* analysis. *KSR*, 127 S. Ct. at 1741, 82 U.S.P.Q. 2d at 1389. As long as the TSM test is not applied as a “rigid and mandatory” formula, the test can provide “helpful insight” to an obviousness inquiry. *Id.*

Applicants respectfully traverse this rejection because even if Murray, Sweger, Babenko, and Saint-Leger can be properly combined in the manner asserted by the Office, which Applicants do not concede, the resultant combination does not possess each and every element of at least amended claim 1. In particular, the cited references do not teach a cosmetic composition comprising, *inter alia*, at least one “non-volatile polyorganosiloxane chosen from: polyalkylsiloxanes chosen from . . . polydimethylsiloxanes comprising trimethylsilyl end groups; - polyarylsiloxanes;

- polyalkylarylsiloxanes; - silicone resins; and - polyorganosiloxanes comprising substituted or unsubstituted amine groups[.]" as claimed. See amended claim 1.

Murray discloses hair conditioning compositions containing *inter alia*, a non-volatile emulsion polymerized silicone *gum*, such as dimethiconol. See Murray, column 1, lines 5-7 ("[t]his invention relates to hair conditioning compositions containing non-volatile insoluble *silicone gum*, particularly dimethiconol *gum*.") (emphasis added). Thus, Murray discloses silicone *gums*, and in particular a silicone gum that is a polyalkylsiloxane having dimethylsilanol end groups. Moreover, Murray's compositions exhibit substantially improved conditioning properties, due to the "superior hair conditioning properties" of the emulsion polymerized dimethiconol material.

The present claims, however, do not encompass silicone gums, and certainly do not encompass silicone gums comprising a polyalkylsiloxanes having dimethylsilanol end groups. Accordingly, Murray does not teach or even suggest each and every element of the present claims for at least this reason.

Sweger does not cure the deficiencies of Murray. Sweger discloses personal care compositions that may include an emulsion derived from, among other things, silicone oils and fats. See Sweger, column 4, lines 39-55. However, Sweger makes no mention of silicones falling within the scope of the present claims. Rather, Sweger discloses the use of dimethicone and dimethicone copolyol, which are the same or essentially the same as the silicone gums disclosed by Murray. See *id.* at columns 7-13, tables. Thus like Murray, Sweger also does not teach or suggest a composition comprising at least one non-volatile polyorganosiloxane within the scope of the pending claims. See claim 1.

Babenko also does not teach or suggest a cosmetic composition comprising the claimed at least one non-volatile polyorganosiloxane. Babenko discloses oil-in-water emulsions for use in cosmetic compositions. See Babenko, column 1, lines 40-45. These emulsions contain a silicone copolyol of the structure shown by Figure II, and optionally dimethicone and/or cyclomethicone. See *id.* at columns 5-12, tables. However, none of these silicones fall within the purview of the present claims. At best, the disclosed silicone copolyol could be considered a polyorganosiloxane modified with an ether, but such a compound does not fall within the scope of present claim 1. As to dimethicone and cyclomethicone, these compounds are not encompassed within present claim 1 for the same reasons set forth above with respect to Murray and Sweger. Accordingly, like Murray and Sweger, Babenko also fails to teach or suggest each and every element of the present claims.

Saint-Leger does not cure the deficiencies of Murray, Sweger, and Babenko. In general, Saint-Leger is drawn to compositions for preventing hair loss. See Saint-Leger, column 1, lines 10-17. In some embodiments, Saint-Leger discloses compositions that include silicones such as polydimethylsiloxane and polyaminosiloxane. See *id.* at column 5, table. However, Saint-Leger is completely silent with respect to, *inter alia*, a hair care composition comprising a combination of at least one amphoteric starch and at least one non-volatile silicone, as claimed. See claim 1. Thus, like Murray, Sweger, and Babenko, Saint-Leger does not teach or suggest each and every element of the pending claims.

Accordingly, *none* of the references cited by the Office teach or suggest a cosmetic composition within the scope of the pending claims, i.e., which contains, *inter*

alia, a combination of amphoteric starch and at least one non-volatile silicone within the scope of amended claim 1.

In addition, the Office has provided no tenable rationale explaining *why* one of ordinary skill in the art would have combined the disparate teachings of the cited references in an attempt to arrive at the claimed invention. As explained above, each of the references cited by the Office are silent with respect to compositions that comprise, *inter alia*, the claimed combination of amphoteric starch and at least one non-volatile silicone. Moreover Murray, the primary reference relied on by the Office, strongly suggests the use of silicones that are not encompassed by the present claims, i.e., dimethiconols, by indicating that those silicones exhibit “superior” conditioning performance. See Murray, column 6, lines 40-45.

Given this indication, the Office has not explained *why* one of ordinary skill in the art would have modified Murray to substitute silicones within the scope of the pending claims for the disclosed dimethiconols, when none of the cited references teach or suggest such a modification. Moreover, the Office has not explained *why* one of ordinary skill in the art would expect such a modification to result in a composition that exhibits equal, much less better results as the compositions disclosed by Murray.

Applicants acknowledge the Office’s assertions that “Murray teaches insoluble siloxane is generally known to be useful for shampoo . . .” and thus, “the substitution of dimethiconol with other siloxane known to be useful in shampoo composition would have been obvious to one of ordinary skill in the art.” But Applicants respectfully disagree with the Office’s argument for at least two reasons.

First, Applicants respectfully disagree with the Office's argument because it is based on an incorrect interpretation of the disclosure of Murray. Contrary to the Office's assertions, Murray does not disclose the use of insoluble siloxanes in general. Rather, Murray discloses the use of insoluble siloxane *gums*, which are not within the scope of the pending claims. See Murray, column 1, lines 5-7 ("This invention relates to hair conditioning compositions containing non-volatile insoluble silicone *gum*, particularly dimethiconol *gum*.") (emphasis added).

Second, Applicants respectfully disagree with and traverse the Office's position, at least because it is not supported by evidence. In this regard, Applicants respectfully remind the Office that the Court of Appeals for the Federal Circuit ("CAFC") has clearly explained that while the USPTO examiners may rely upon what is generally known in the art, they **must** provide evidentiary proof of that knowledge. See *In re Zurko*, 59 U.S.P.Q.2d 1693, 1697 (Fed. Cir. 2001) ("With respect to core factual findings in a determination of patentability, however, the Board cannot simply reach conclusions based on its own understanding or expertise . . . Rather, the Board **must point to some concrete evidence** in the record in support of these findings.") (emphasis is added). Here, however, the Office has not pointed to any evidence, much less *concrete* evidence, in support of its assertions that one skilled in the art would have found it obvious to substitute non-volatile insoluble silicones within the scope of the pending claims for the insoluble silicone gums (e.g., dimethiconol) in an attempt to arrive at the claimed invention. Rather, the Office has merely concluded, without evidence, that such is the case. Such reasoning is clearly counter to the CAFC's holding in *Zurko*, and is insufficient to establish a *prima facie* case of obviousness.

For at least the foregoing reasons, Applicants respectfully submit that none of the references cited by the Office teach or suggest each and every element of the pending claims. Moreover, Applicants respectfully submit that the Office has not explained *why* one of ordinary skill in the art at the time the claimed invention was would have modified the cited references in an attempt to arrive at the claimed invention. Thus, Applicants respectfully submit that the 35 U.S.C. § 103(a) rejection of claims 1-10, 12, 14, 16-18 and 30-34 as being unpatentable over Murray, Sweger et al, Babenko and Saint-Leger is improper, and should be withdrawn.

IV. Conclusion

In view of the foregoing amendments and remarks, Applicants respectfully request reconsideration and reexamination of this application and the timely allowance of the pending claims.

Please grant any extensions of time required to enter this response and charge any additional required fees to our deposit account 06-0916.

Respectfully submitted,

FINNEGAN, HENDERSON, FARABOW,
GARRETT & DUNNER, L.L.P.

Dated: November 12, 2008

By: 

Nikolas J. Uhrir
Reg. No. 62,201
(617) 452-1682